

Application Number **09/761,795**
Amendment dated **24 October 2005**
Reply to Office Action of **22 April 2005**

Remarks

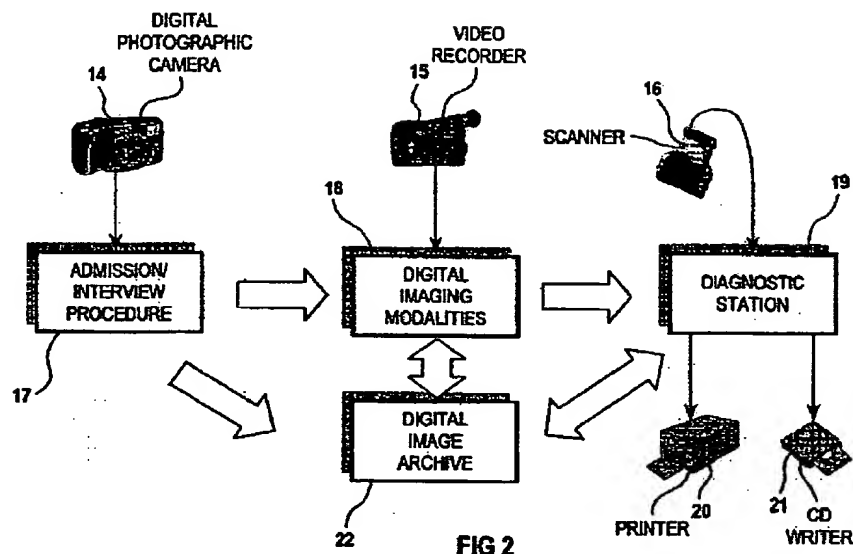
Applicants have not added any claims, and have cancelled Claims 30 and 32. Therefore, Claims 1–29, 31 and 33–36 remain pending in this Application. Claims 1, 13, 23, 29, 31, 34 and 36 are independent.

Claim Rejections Under 35 U.S.C. § 102(e).

Claims 1, 2, 7–11, 13–15, 17–21, 34 and 35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,241,668 ("Herzog"). Claims 2 and 7–11 depend from independent Claim 1. Claims 14, 15 and 17–21 depend from independent Claim 13. Claim 35 depends from independent Claim 34.

Herzog discloses a system for capturing, processing and storing medical image data (1:5–10). The Herzog system includes several devices, referred to as digital imaging modalities (18), that are configured to acquire medical images; examples of such modalities include a computed tomography unit, a magnetic resonance unit, a digital subtraction unit, and an x-ray unit (2:21–26). The Herzog system also includes a diagnostic station (19) that is configured to acquire medical image data from a number of different sources, such as from the digital imaging modalities (3:23–28), from a digital image archive (22) (3:28–31), or from a scanner (16) used to scan relevant documents (3:32–36). The medical image data acquired by the diagnostic station can be recorded onto a compact disc using a compact disc writer (21) (3:43–49). A schematic illustration of the Herzog system is provided in Figure 2, which is reproduced here for the Examiner's convenience.

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Claims 1, 2 and 7-11. In contrast to the teachings of Herzog, independent Claim 1 recites a system that comprises, among other things,

a viewing program configured to view said first set of medical image data is stored on said portable digital recording medium.

Applicants respectfully submit that this element is not taught by Herzog. The Examiner cites Herzog at 3:40-50 and 4:15-23 as teaching this element. However, the first of these passages merely discloses that the medical images can be stored on a compact disc using a compact disc writer, so that they can be observed by a user who does not have access to the diagnostic station. The second of these passages merely discloses that the images acquired using the modalities "offer standardized JPEG software interfaces", thus allowing the images to be distributed over the Internet or using a compact disc. Nowhere does Herzog teach that a viewing program "is stored on said portable digital recording medium", as is recited in independent Claim 1.

Based on the foregoing, Applicants submit that independent Claim 1 is not anticipated by Herzog, and respectfully request that this rejection be withdrawn. Furthermore, because dependent Claims 2 and 7-11 depend from independent Claim 1, and further recite additional novel and nonobvious features, Applicants submit that dependent Claims 2 and 7-11 are allowable for at least the same reasons that

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independent Claim 1 is allowable. Thus, Applicants respectfully request that these dependent claim rejections be withdrawn as well.

Claims 13-15 and 17-21. In contrast to the teachings of Herzog, independent Claim 13 recites a method that comprises, among other things,

storing said first set of medical image data on said portable digital recording medium, wherein a viewing program configured to view said first set of medical image data is stored on said portable digital recording medium.

Applicants respectfully submit that this element is not taught by Herzog. The Examiner cites Herzog at 3:40-50 and 4:15-23 as teaching this element. However, the first of these passages merely discloses that the medical images can be stored on a compact disc using a compact disc writer, so that they can be observed by a user who does not have access to the diagnostic station. The second of these passages merely discloses that the images acquired using the modalities "offer standardized JPEG software interfaces", thus allowing the images to be distributed over the Internet or using a compact disc. Nowhere does Herzog teach that a viewing program "is stored on said portable digital recording medium", as is recited in independent Claim 13.

Based on the foregoing, Applicants submit that independent Claim 13 is not anticipated by Herzog, and respectfully request that this rejection be withdrawn. Furthermore, because dependent Claims 14, 15 and 17-21 depend from independent Claim 13, and further recite additional novel and nonobvious features, Applicants submit that dependent Claims 14, 15 and 17-21 are allowable for at least the same reasons that independent Claim 13 is allowable. Thus, Applicants respectfully request that these dependent claim rejections be withdrawn as well.

Claims 34 and 35. In contrast to the teachings of Herzog, amended independent Claim 34 recites a method that comprises, among other things,

storing said first set of medical image data on said portable digital recording medium, wherein a viewing program configured to view said first set of medical image data is stored on said portable digital recording medium.

Applicants respectfully submit that this element is not taught by Herzog. The Examiner cites Herzog at 3:40-50 and 4:15-23 as teaching this element. However, the first of these passages merely discloses that the medical images can be stored on a compact disc using a compact disc writer, so that they can be observed by a user who does not

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have access to the diagnostic station. The second of these passages merely discloses that the images acquired using the modalities "offer standardized JPEG software interfaces", thus allowing the images to be distributed over the Internet or using a compact disc. Nowhere does Herzog teach that a viewing program "is stored on said portable digital recording medium", as is recited in amended independent Claim 34.

Based on the foregoing, Applicants submit that amended independent Claim 34 is not anticipated by Herzog, and respectfully request that this rejection be withdrawn. Furthermore, because dependent Claim 35 depends from amended independent Claim 34, and further recites additional novel and nonobvious features, Applicants submit that dependent Claim 35 is allowable for at least the same reasons that amended independent Claim 34 is allowable. Thus, Applicants respectfully request that this dependent claim rejection be withdrawn as well.

Claim Rejections Under 35 U.S.C. § 103(a).

Claims 3 and 4. Claims 3 and 4 stand rejected as being unpatentable over Herzog in view of U.S. Patent 5,272,625 ("Nishihara"). Claims 3 and 4 depend from independent Claim 1. Nishihara does not provide the deficiencies of Herzog, as set forth above with respect to Claim 1. Therefore, Applicants respectfully submit that Claims 3 and 4 are allowable for at least the same reasons explained above with respect to Claim 1, in addition to reciting further distinguishing features of particular utility.

Claims 5 and 16. Claims 5 and 16 stand rejected as being unpatentable over Herzog in view of U.S. Patent Application Publication 2004/0078236 ("Stoodley"). Claim 5 depends from independent Claim 1, and Claim 16 depends from independent Claim 13. Stoodley does not provide the deficiencies of Herzog, as set forth above with respect to Claims 1 and 13. Therefore, Applicants respectfully submit that Claims 5 and 16 are allowable for at least the same reasons explained above with respect to Claims 1 and 13, respectively, in addition to reciting further distinguishing features of particular utility.

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Claims 6 and 12. Claims 6 and 12 stand rejected as being unpatentable over Herzog in view of U.S. Patent 6,564,256 ("Tanaka"). Claims 6 and 12 depend from independent Claim 1. Tanaka does not provide the deficiencies of Herzog, as set forth above with respect to Claim 1. Therefore, Applicants respectfully submit that Claims 6 and 12 are allowable for at least the same reasons explained above with respect to Claim 1, in addition to reciting further distinguishing features of particular utility.

Claim 22. Claim 22 stands rejected as being unpatentable over Herzog in view of Tanaka. Claim 22 depends from independent Claim 13. Tanaka does not provide the deficiencies of Herzog, as set forth above with respect to Claim 13. Therefore, Applicants respectfully submit that Claim 22 is allowable for at least the same reasons explained above with respect to Claim 1, in addition to reciting further distinguishing features of particular utility.

Claims 23 and 25-28. Claims 23 and 25-28 stand rejected as being unpatentable over Herzog in view of Tanaka. Claims 25-28 depend from independent Claim 23.

Tanaka discloses an image transfer system capable of transmitting medical image data between a plurality of terminals and a database where the medical image data is stored (8:44-49). The medical image data is stored in the database using the Digital Imaging and Communication in Medicine (DICOM) standard, but is converted to a different protocol before transfer to a terminal; this allows the medical image data to be viewed using a web browser (8:49-64).

In contrast to the teachings of Herzog and Tanaka, independent Claim 23 recites a method that comprises, among other things,

recording said selected first set of medical image data on said portable digital recording medium, wherein a viewing program configured to view said first set of medical image data is stored on said portable digital recording medium.

Applicants respectfully submit that this element is taught by neither Herzog nor Tanaka. The Examiner cites Herzog at 3:40-50 and 4:15-23 as teaching this element. However, the first of these passages merely discloses that the medical images can be stored on a compact disc using a compact disc writer, so that they can be observed by a user who does not have access to the diagnostic station. The second of these

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passages merely discloses that the images acquired using the modalities "offer standardized JPEG software interfaces", thus allowing the images to be distributed over the Internet or using a compact disc. Nowhere does Herzog teach that a viewing program "is stored on said portable digital recording medium", as is recited in independent Claim 23. Of course, Tanaka does not even teach use of a portable digital recording medium, much less a viewing program stored thereon.

Based on the foregoing, Applicants submit that independent Claim 23 is patentable over the combination of Herzog and Tanaka, and respectfully request that this rejection be withdrawn. Furthermore, because dependent Claims 25-28 depend from independent Claim 23, and further recite additional novel and nonobvious features, Applicants submit that dependent Claims 25-28 are allowable for at least the same reasons that independent Claim 23 is allowable. Thus, Applicants respectfully request that these dependent claim rejections be withdrawn as well.

Claim 24. Claim 24 stands rejected as being unpatentable over Herzog in view of Tanaka and Stoodley. Claim 24 depends from independent Claim 23. Stoodley does not provide the deficiencies of Herzog and Tanaka, as set forth above with respect to Claim 23. Therefore, Applicants respectfully submit that Claim 24 is allowable for at least the same reasons explained above with respect to Claim 23, in addition to reciting further distinguishing features of particular utility.

Claims 29 and 30. Claims 29 and 30 stand rejected as being unpatentable over Herzog in view of Tanaka. Claim 29 is independent. Claim 30 has been cancelled.

In contrast to the teachings of Herzog and Tanaka, amended independent Claim 29 recites a method that comprises, among other things,

performing a search of said computer database for medical data related to the selected first set of said medical image data, wherein results of said search are compiled into a second set of medical data; and
recording said selected first set of medical image data and said compiled second set of medical data on said portable digital recording medium.

Applicants respectfully submit that these elements are taught by neither Herzog nor Tanaka. Applicants have amended independent Claim 29 to clarify that a search is performed "for medical data related to the selected first set of medical image data", and that the "selected first set of medical image and said compiled second set of medical

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data" are recorded onto the portable digital recording medium. In contrast to the recitations of amended independent Claim 29, Herzog simply teaches that digital optical images acquired by a digital imaging modality, a digital image archive, or a scanner are directly recorded to a compact disc. Neither Herzog nor Tanaka contains any teaching of "performing a search". Therefore, Applicants submit that amended independent Claim 29 is patentable over the combination of Herzog and Tanaka, and respectfully request that this rejection be withdrawn.

Claims 31–33. Claims 31–33 stand rejected as being unpatentable over Herzog in view of Tanaka. Claim 32 has been cancelled. Claim 33 depends from independent Claim 31.

In contrast to the teachings of Herzog and Tanaka, amended independent Claim 31 recites a system that comprises, among other things,

a processing module configured to (a) process said first set of medical image data, (b) search a medical data storage unit for medical data related to said first set of medical image data, and (c) compile results of the search into a second set of medical data; and

an output module configured to transmit said first set of medical image data and said second set of medical data to a production device configured to record said first set of medical image data and said second set of medical data on said portable digital recording medium.

Applicants respectfully submit that this element is taught by neither Herzog nor Tanaka. Applicants have amended independent Claim 31 to clarify that the processing module is configured to "search a medical image data storage unit for medical data related to said first set of medical image data", among other things. In contrast to amended independent Claim 31, Herzog simply teaches that digital optical images acquired by a digital imaging modality, a digital image archive, or a scanner are directly recorded to a compact disc. Neither Herzog nor Tanaka contains any teaching of a module that is configured to "search a medical data storage unit".

Based on the foregoing, Applicants submit that amended independent Claim 31 is patentable over the combination of Herzog and Tanaka, and respectfully request that this rejection be withdrawn. Furthermore, because dependent Claim 33 depends from amended independent Claim 31, and further recites additional novel and nonobvious features, Applicants submit that dependent Claim 33 is allowable for at least the same

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reasons that amended independent Claim 31 is allowable. Thus, Applicants respectfully request that this dependent claim rejection be withdrawn as well.

Claim 36. Independent Claim 36 stands rejected as being unpatentable over Herzog in view of Tanaka.

In contrast to the teachings of Herzog and Tanaka, amended Independent Claim 36 recites a method comprising, among other things,

connecting said application server to a first production device and a second production device, said first production device and said second production device each configured to record said first set of medical image data on said portable digital recording medium

selecting, on the basis of said first set of medical image data, a target production device from a list of said first production device and said second production device;

Applicants respectfully submit that these elements are taught by neither Herzog nor Tanaka. Herzog discusses a system that includes only one compact disc writer, and Tanaka does not even teach use of a production device configured to record data on a portable digital recording medium. Therefore, neither Herzog nor Tanaka disclose "a first production device and a second production device" (emphasis added) as recited in amended independent Claim 36. Furthermore, because neither Herzog nor Tanaka disclose a first production device and a second production device, neither reference teaches "selecting ... a target production device". Therefore, Applicants submit that amended independent Claim 36 is patentable over the combination of Herzog and Tanaka, and respectfully request that this rejection be withdrawn.

Conclusion.

Applicants respectfully submit that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be

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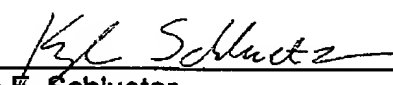
implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter. If some issue remains that the Examiner feels can be addressed by an Examiner's Amendment, the Examiner is cordially invited to call the undersigned for authorization.

Respectfully submitted,

KNOBBE MARTENS OLSON & BEAR LLP

Dated: _____

By: _____


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